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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,676	11/04/2003	Takashi Yamada	244838US2S	6468
22850	7590	06/15/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			NGUYEN, CUONG QUANG	
			ART UNIT	PAPER NUMBER
			2811	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,676

Applicant(s)

YAMADA ET AL.

Examiner

Cuong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 4-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04-26-05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Yamada et al. (US 2003/0151112 A1).

Yamada et al. Discloses a semiconductor device comprising: a substrate (10) having first to fourth regions (TR1, TR2, TR4, TR5); a first insulating film (BOX) formed on the substrate in the first region (TR4); a first epitaxial layer (13) [0061] formed on the substrate in the second region (TR1) and having an upper surface higher than an upper surface of the first insulating film; a first semiconductor layer (12) formed on the first insulating film with a space provided with respect to the first epitaxial layer and having an upper surface set at substantially the same height as the upper surface the first epitaxial layer; and an element isolation insulating film (a center STI) formed in the space and having an upper surface set at substantially the same height as the upper surface of the first epitaxial layer and the upper surface of the first semiconductor layer, the element isolation insulation film being formed on a side surface of the first insulating film, and the

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first epitaxial layer being in contact with the element isolation insulating film and the first insulating film. See Yamada et al.'s Fig.1A to Fig.1D.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. in view of Sugawara et al. (US 6,750,486).

Yamada et al. teaches all the limitations of claim 1 as shown above but does not explicitly material for element isolation insulation film (STI).

It is known and also taught by Sugawara et al. (col.7 lines 34-37) that silicon oxide is an art recognized material for forming the STI region.

It would have been obvious to one of ordinary skill in the art to form the STI by conventional material such as silicon oxide as taught by Sugawara et al. because silicon oxide is known, cheap, and good insulating material between active semiconductor layers.

It is noted that the device being formed by the combination of Yamada et al. and Sugawara et al. has first insulating film (BOX) (a silicon oxide layer) [0036] and element isolation insulating film (also is a silicon oxide layer) are formed of the same material.

Response to Arguments

3. Applicant's arguments filed 04-26-05 have been fully considered but they are not persuasive. Applicants argue that the STI in Yamada et al. does not form on the first insulating film. In response, as clearly shown in Yamada et al.'s Fig.1, the center STI formed on the side surface of the first insulating film BOX. It is noted that, the claim language does not require that the element isolating film formed on "a top surface" of the first insulating film, so the Yamada et al's Fig.1 still read on the claimed limitation.

Allowable Subject Matter

4. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is an examiner's statement of reasons for allowance: a above combination of references appears to be the closest prior art reference. However, this combination fails to teach that a second epitaxial layer formed on the substrate in the fourth region, having an upper surface set at substantially the same height as an upper surface of the second semiconductor layer and formed in contact with the second insulating film and second semiconductor layer. Prior art of record fails to teach or

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suggest to incorporate these limitations into above references to arrive at the claimed device.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Papers related to this application may be submitted to Technology center (TC) 2800 by facsimile transmission. Papers should be faxed to TC 2800 via the TC 2800 Fax center located in Crystal Plaza 4, room 4-C23. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 2811 Fax Center number is (703) 872-9306. The Group 2811 Fax Center is to be used only for papers related to Group 2811 applications.

8. Any inquiry concerning this communication or any earlier communication from the Examiner should be directed to CUONG Q NGUYEN whose telephone number is

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(571) 272-1661. The Examiner is in the Office generally between the hours of 6:30 AM to 5:00 PM (Eastern Standard Time) Monday through Thursday.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Eddie Lee who can be reached on (571) 272-1732.

Cuong Nguyen

Primary examiner

6/8/05

A handwritten signature in black ink, appearing to read 'Cuong Nguyen', with a long, sweeping vertical line extending downwards from the end of the signature.